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09/485,034	02/02/2000	ROBERT JOHN BLYTHE	PAR20013	1407

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EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/28/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,034

Applicant(s)

BLYTHE, ROBERT JOHN

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,15,17-20,23 and 26 is/are rejected.
- 7) ☒ Claim(s) 12-14,21 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The rejection of claims 1-6, 10-14 and 19-26 under 35 U.S.C. 102(b) as being anticipated by Japanese Patent translation JP 54-48927 is withdrawn in view of applicants amendments.

The rejection of claims 1-6, 10-13, 19-20 and 22-23 under 35 U.S.C. 102(b) as being anticipated by Biotteau 4,337,292 is withdrawn in view of applicants amendments.

The rejection of claims 8-9 and 16 under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent translation JP 54-48927 (Kobayashi) or Biotteau 4,337,292 in view of Auerbach et al, 3,916,969 and Bartley et al, 4,201,261 is moot in view of applicants amendments.

The cancellation of claims 8, 10, and 16 is noted. Currently, claims 1-7, 9, 11-15, and 17-26 are pending.

General Remarks

For the record, the examiner has interpreted the term "agglomerate" to mean "a confused or jumbled mass of things clustered together; heap" as defined by the "American Heritage Dictionary, Second College Edition", 1982, pages 86-87. Accordingly, the examiner has interpreted the language of "an agglomerate of granules of a thermoplastic elastomer" as set forth in the claims to mean a jumbled mass or heap of granules of thermoplastic elastomer.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a support or bulk layer comprising a blend of rubber granules and polyurethane binder as described on pages 10-11 of the specification, does not reasonably provide enablement for a support or bulk layer that "comprises a rubber in granular form". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. More specifically, while the language of "comprises" in claim 24 is open-ended and does not necessarily exclude the presence of a binder, the claim as written includes and embraces unbound rubber granules. It is not readily apparent as to how unbound rubber particles would function as a support or bulk layer in a wearing course, particularly since claim 1, by definition encompasses an agglomerate or heap of thermoplastic elastomer granules. Accordingly, this claim is not commensurate in scope with the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 19-20, 22, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claim 11 is indefinite because it is not clear as to what includes the pigment.

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Claim 19 is indefinite because it depends on claim 1, which by definition sets forth a heap of thermoplastic elastomer granules. Hence, claim 19, in further defining claim 1, embraces a laid layer of heaps of thermoplastic elastomer granules. Accordingly, the metes and bounds for which patent protection is being sought have not been clearly defined.

Claim 20 is indefinite because is it not clear as to what has the referenced thickness. Also the language of "especially 2cm to 6cm" is indefinite because this language leads to confusion of the intended scope of the claim since it is not clear if this range is a limitation of the claim.

Claim 22 is indefinite because it is not clear as to what has been laid in direct contact with the ground.

Claim 26 is indefinite because the language of "especially from 2cm to 6cm" leads to confusion of the intended scope of the claim and it is not clear if this is a limitation of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 9, 15, 17, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins et al, 5,088,724 (Hawkins).

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Hawkins teaches construction materials for sports surfaces comprising particulate or granular material treated with a binder comprising extender oil having a polymeric material dissolved or dispersed therein. The polymer is a thermoplastic elastomer, per claims 7, 15 and 17, wherein said elastomer is a styrene block copolymer as required by claim 1, and can be styrene-butadiene-styrene (SBS) as required by claim 9. See column 1, lines 6 and 57-58. The polymer is in the form of pellets. See Example. Claim 1 by definition is drawn to a jumbled mass or heap of thermoplastic elastomer granules and claim 15 is drawn to granules of thermoplastic elastomer. Presumably the pellets used by Hawkins are a jumbled mass or heap. Pellets of thermoplastic elastomer are known. To gather them together to form an agglomerate, jumbled mass or heap is not construed to be inventive. Regarding claim 17, though Hawkins teaches that the SBS particles are dissolved or dispersed in oil, he nonetheless teaches a composition comprising a first component comprising granular thermoplastic elastomer and a second component comprising a binding agent, wherein this composition is to be used for a wearing course. Regarding claims 19 and 23, Hawkins teaches that the material can be laid in a layer having a bulk supporting layer underneath. See column 2, lines 33-36.

Accordingly, the teachings of Hawkins anticipate the invention as claimed in claims 1, 7, 9 and 17.

Claims 7, 15 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent translation JP 54-48927, Kobayashi for reasons of record.

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Claims 7, 15, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Biotteau, 4,337,292, for reasons of record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al, 5,088,724, as applied above to claims 1, 7, 9, 17, 19 and 23.

Hawkins is as set forth above but is silent as to the specific shape and dimensions of the pellets. Regarding claims 5-6, 20 and 26, it is the examiner's position that these limitations are not patentably significant since they relate to the size of the granules under consideration, wherein size is not ordinarily a matter of invention. *In re Rose*, 105 USPQ 237 (CCPA 1955). As to claims 2-3, these claims are drawn to the shape of the granules and there is no clear evidence of record that the specific shape of the granules is significant. *In re Dailey*, 149 USPQ 47 (CCPA 1976). As to claim 4, while Hawkins is silent as to the presence of dust, it is the examiner's position that this limitation is not a matter of invention in the absence of clear factual evidence to the contrary. Accordingly, Hawkins would have rendered obvious the invention as claimed in claims 2-6, 20 and 26.

Response to Arguments

Applicant's arguments filed August 8, 2003 have been fully considered but they are not persuasive.

Applicants argue that Kobayashi teaches a polyurethane or styrene-butadiene rubber, and the use of the term "rubber" clearly indicates a vulcanized material and not a thermoplastic elastomer, further arguing that Kobayashi does not disclose or fairly suggest that the "polyurethane rubber" referred to is a thermoplastic elastomer or, indeed suggest the use of thermoplastic elastomers in general.

In this regard, Kobayashi teaches at page 6, "chips or natural rubber, styrene-butadiene rubber, ...polyurethane rubber, etc. as well as their vulcanized rubber are given..." This teaching clearly embraces both vulcanized and unvulcanized rubbers and is not so limited as argued by applicants. Furthermore, the teaching of polyurethane rubber necessarily embraces thermoplastic elastomers and the skilled artisan would immediately envisage such.

Applicants argue that no disclosure can be seen in Biotteau of any thermoplastic elastomer and that none of the solid materials referred to at column 2, lines 7-15 are thermoplastic elastomers. Applicants further argue that the polyurethane disclosed by Biotteau is not disclosed as a thermoplastic elastomer.

In response thereto, Biotteau teaches that the polyurethane is a polyurethane elastomer. Clearly this teaching encompasses a thermoplastic elastomer and, clearly the polyurethane taught by Biotteau is an elastomer. Moreover, there is no factual evidence of record supporting applicants' allegation that a polyurethane elastomer is not a thermoplastic elastomer.

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Applicants argue that Biotteau does not disclose the use of a styrene block copolymer.

Agreeably Biotteau is silent as to a styrene block copolymer. However, claims 7, 15, and 17 are not so limited.

Applicant's arguments with respect to claims 1-7, 9, 17, 19-20, 23, and 26 have been considered but are moot in view of the new ground(s) of rejection.

Applicants have not clearly defined that which they regard as their invention. The following claims are suggested for applicants' consideration:

A construction material for use in a wearing course comprising granules of a thermoplastic elastomer bound together, wherein said thermoplastic elastomer comprises a styrene block copolymer.

A composition for use in a wearing course comprising:
(a) a first component comprising a granular thermoplastic elastomer comprising a styrene block copolymer; and
(b) a second component comprising a binding agent for the granules.

Claims 12-14, 21 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Claims 11 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 703.308.2381. The examiner can normally be reached on M-F 10:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.


Jill M. Gray
Examiner
Art Unit 1774

jmg